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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,280	12/21/2001	Rahul Singhvi	H00498/70173 TJO	6387

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EXAMINER

WARE, DEBORAH K

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/032,280	Applicant(s) SINGHVI ET AL.	
	Examiner Deborah K. Ware	Art Unit 1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 109, 111 and 129-145 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 109, 111 and 129-145 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election

Although the election was filed with traverse, Applicants presented no arguments and canceled all non-elected claims and thus, the election is being treated as being without traverse instead. Applicant's election without traverse of Group XV (claims 109-111) in the reply filed on August 12, 2004 is acknowledged.

Claims 109, 111 and newly added claims 129-145 are presented for examination on the merits.

Other Papers

The extension of time filed August 2, 2004 to file election to requirement of April 29, 2004, has been received. The status letter of October 20, 2003, was received. Also Preliminary amendments of December 19, 2002, June 26, 2002 were received. Further, the miscellaneous letter of March 29, 2002 was received. The drawings filed December 21, 2002 are acceptable to the examiner.

Specification

Applicants are requested to update the status of the parent cases at page 1, lines 5-10 of the instantly filed specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 109, 111 and 129-145 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims fail to be supported for the term "immobilization islands" recited in the claims. The term fails to be properly defined and supported by the instantly filed specification. No where in the specification can support be found for this new term which is deemed new matter. The specification is considered to be non-enabling for the instantly claimed subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 109, 111 and 129-145 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 109, 111 and 129-145 are rendered vague and indefinite for the recitation of "immobilization islands" which is unclear and not well defined in the claims or the supported by the specification. Also the claims are rendered vague and indefinite for the recitation of "background region" which is unclear as to what constitutes or what is a

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"background region" per se. What exactly is isolating the islands from each other? The metes and bounds of the claims can not be determined.

Claim 131 and 134 and 141-145 lack consistent antecedent basis for the recitation of "the immobilization islands" and should be changed to --the plurality of immobilization islands--.

Claim 136 is rendered grammatically indefinite for the recitation of "of a second population of cells" at bridging lines 2-3. The "of" should be deleted.

Claims 139-140 lack antecedent basis for the recitation of "The method" since no method is claimed in claim 109. Term "method" should be changed to --device--.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 109, 111 and 129-145 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 and 18-20 of U.S. Patent No. 5,776,748. Although the conflicting claims are not identical, they are

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not patentably distinct from each other because the only difference between the patented claims and instant claims is scope.

Claims are drawn to a device comprising a surface and a plurality of immobilization islands.

The US Patent cited herein teaches a device comprising a surface and a plurality of cytophilic islands and cytophobic regions that both function together to adhere cells to form a pattern and further comprise SAMs (self-assembled monolayers).

The claims differ from the US Patent in that immobilization islands are claimed.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use the cytophilic islands and cytophobic regions of the US Patent as immobilization islands. Clearly one of skill would have expected successful results for immobilization and especially since a method of immobilization is taught in claims 18-20. The claims are prima facie obvious over this cited patent.

Claims 109, 111 and 129-145 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 and 20 of U.S. Patent No. 5,976,826. Although the conflicting claims are not identical, they are not patentably distinct from each other because other because the only difference between the patented claims and instant claims is scope.

The US Patent cited herein teaches a device comprising a surface and a plurality of cytophilic islands and cytophobic regions that both function together to adhere cells to form a pattern, and further comprise SAMs (self-assembled monolayers).

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It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use the cytophilic islands and cytophobic regions of the US Patent as immobilization islands. Clearly one of skill would have expected successful results for immobilization and especially since a method of immobilization is taught in claim 20. The claims are prima facie obvious over this cited patent.

Claims 109, 111 and 129-145 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-15 of U.S. Patent No. 6,368,838. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the patented claims and instant claims is scope.

Claims are drawn to a device comprising a surface and a plurality of immobilization islands.

The US Patent cited herein teaches a device comprising a surface and a plurality of regions that adhere cells to form a pattern and further comprise SAMs (self-assembled monolayers).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine cytophilic and cytophobic regions as disclosed by the cited US Patent to provide for immobilization islands. Clearly one of skill would have expected successful results for immobilization since some of the cells would adhere in different places giving the appearance of cellular islands and forming a pattern on the surface. The claims are prima facie obvious over this cited patent.

All claims fail to be free over the state of the art discussed above and cited on the enclosed PTO-892 and/or PTO-1449. Therefore, the claims are properly rejected.

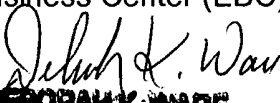
The remaining references listed on the enclosed PTO-892 and/or PTO-1449 are cited to further show the state of the art.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah K. Ware whose telephone number is 571-272-0924. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


DEBORAH K. WARE
PATENT EXAMINER

Deborah K. Ware
October 30, 2004